

REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance.

Claims 1, 2, 7-12, 15, 19, 22-24, 29, 31 and 33-37 are pending in this application. Claims 1, 2, 7, 8, 19, 12, 15 and 19 are amended; claims 3 and 4 are cancelled; and new claims 34-37 are added, without prejudice. Applicant reserves the right to pursue cancelled subject matter in a divisional application.

No new matter is added.

The amendments and the remarks made herein are not made for reasons related to patentability and, thus, do not prevent the application of the doctrine of equivalents. Support for the amended recitations in the claims and for the new claims are found throughout the specification and from the pending claims.

Claims 1-4, 7-12, 15, 19, 22-24, 29, 31 and 33 were rejected under 35 U.S.C. §112, second paragraph, for allegedly being indefinite; claims 1-4, 7-12, 15, 19, 22-24, 31 and 33 were rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking written description; and claims 1-4, 7-12, 15, 19, 22-24, 29, 31 and 33 were rejected under 35 U.S.C. §112, first paragraph, for allegedly lacking enablement. The rejections are traversed.

The amendments to the claims, without prejudice, render the instant rejections moot. With respect to the Section 112, first paragraph, rejections, written description and enablement exist. For example, the specification on page 7, second paragraph, states that plant cells according to the invention can be produced “by means of various procedures known to the person skilled in the art, e.g., by means of those which lead to inhibition of the expression of

endogenous genes which encode a GBSSI or a BE protein. These include for example the expression of a corresponding antisense RNA...and...the provision of molecules or vectors which mediate a cosuppression effect.”

Further, on page 7, third paragraph, it is explained that the foreign nucleic acid molecule can be, for example, a double construct. Further, it is noted in the last paragraph on page 7 of the specification that not only a single specific vector but a number of different foreign acid molecules is introduced into the genome of the plant cell.

Also, on page 8, second paragraph, the cotransformation and super-transformation methods of introducing the foreign nucleic acid molecules into the genome of the plant cell are described. Further, on page 8, lines 22-30, details are presented with respect to suitable sequences which would mediate an antisense effect. It is clearly stated, for example, that not only the entire coding sequence is suitable, but also that parts of the coding sequence are sufficient to mediate an antisense effect. (*See also*, page 9, second paragraph). Therefore, written description and enablement clearly exist.

Consequently, reconsideration and withdrawal of the Section 112, first and second paragraph, rejections are respectfully requested.

Claims 1, 3, 5-6, 12-15, 19, 21-24 and 29 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Flipse et al. The rejection is traversed.

The amendments to the claims, without prejudice, render the rejection moot. More specifically, the document fails to disclose and enable each and every element of the instantly claimed invention.

Consequently, reconsideration and withdrawal of the Section 102 rejection are respectfully requested.

Claims 1-4, 7-12, 15, 19, 22-24, 29, 31 and 33 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,196,226 to Ek et al., taken with Visser et al. and Safford et al., in view of Kossman et al. The rejection is traversed.

The Examiner is respectfully reminded that in order to ground an obviousness rejection, there must be some teaching which would have provided the necessary incentive or motivation for modifying the reference's teaching. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1993). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

The requisite suggestion or motivation is lacking in the documents relied upon in the Office Action. Ek et al. do not teach or suggest potato plants having a reduced BEI and GBSSI activity. Applicants respectfully reiterate that Ek et al. relate to the cloning of the BEII gene from potato and the preparation of transgenic potato plants with decreased BEII gene expression. And Ek et al. relate to the preparation of potato plants having a decreased BEII gene expression and a decreased expression of the GBSSII gene. Ek et al. do not, however, teach, suggest or motivate a skilled artisan to practice potato plants having a decreased GBSSI activity and a decreased BEI activity. In particular, the combination GBSSI + BEI is not taught or suggested in the portions of Ek et al. cited by the Examiner.

The secondary references cited in the Office Action do not remedy the inherent deficiencies in Ek et al. Applicant respectfully reassert that isoforms of the branching enzymes (BEI and BEII) are encoded by distinct genes. And BEI and BEII differ from each other in their physiological functions. Further, and contrary to the inhibition of BEI gene expression, inhibition of BEII expression in potato plants leads to the synthesis of starch with increased amylose content. Thus, the requisite suggestion or motivation to combine the cited documents is absent.

Further, the requisite expectation of success is also lacking in the documents cited by the Examiner. Additionally, it is also well-settled that picking and choosing portions from four disparate references in order to formulate an obviousness rejection is impermissible. Further still, “obvious to try” is not the standard upon which an obviousness rejection should be based. *See In re Fine*. And as “obvious to try” would be the only standard that would lend the Section 103 rejection any viability, the rejection must fail as a matter of law. Therefore, applying the law to the instant facts, the rejection is fatally defective and should be removed.

Consequently, reconsideration and withdrawal of the Section 103(a) rejection is believed to be in order and such actions are respectfully requested.

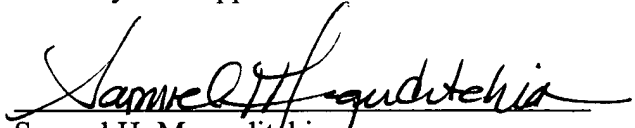
CONCLUSION

In view of the remarks and amendments herewith, the application is in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited.

Respectfully submitted,

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